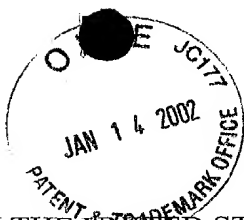


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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

MITSUKO ISHIHARA ET AL.

: EXAMINER: CHAKRABARTI, A.

SERIAL NO: 09/892,485

FILED: JUNE 28, 2001

: GROUP ART UNIT: 1655

FOR: METHOD FOR DETECTING
ENDOCRINE DISRUPTING
ACTION OF A TEST SUBSTANCE

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RESTRICTION RESPONSE

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Responsive to the restriction requirement of December 14, 2001, on the above-identified application, Applicants provisionally elect with traverse to prosecute Group I, directed to Claims 1-10 and 15-20, drawn to a method of gene expression, with traverse.

REQUEST FOR RECONSIDERATION

Restriction has been required from among the following three identified aspects of the present invention:

- 1) Claims 1-10 and 15-20, drawn to a method of gene expression;
- 2) Claims 11-14, drawn to a polynucleotide; and
- 3) Claims 21-23, drawn to an antibody.

Aspects I and III are said to be related as product and process of use. As such, the inventions can be shown to be distinct if either or both of the following can be shown:

1) The process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. MPEP §806.05(h).

In the present case, the Examiner has relied upon the second prong of the above test, being of the opinion that:

...the antibody of Group III can be used in the gene expression method of Group I or can be used in the antibody therapy. See page 2 of the restriction requirement.

Second, aspects I and II are said to be unrelated. The inventions are said to be unrelated if it can be shown that "they are not disclosed as capable of use together and they have different modes of operation, different functions or different effects." See MPEP §806.04 and MPEP §808.01.

In the present case, the Examiner is of the opinion that "the different inventions of method of gene expression of Group I are not disclosed as capable of use together with polynucleotides of Group II and they have different modes of operation, different functions or different effects".

Further, aspects II and III are said to be unrelated, in view of the test set forth above in the preceding paragraph.

Applicants are of the view that the Examiner's comments are disingenuous inasmuch as the claims in Groups II and III are directed to a polynucleotide and an antibody, respectively, each substantially obtained by carrying out the method of Group I. Hence, the present invention is clearly directed to a unitary invention and all aspects are capable of use together.

Hence, for all of the above reasons, it is believed that the requirement for restriction is improper and should be withdrawn.

Furthermore, Applicants are also mindful of the test of MPEP §803, which provides:

If the search and examination of an entire application can be conducted without serious burden, the Examiner is required to search all claims even if directed to independent or distinct inventions.

In the present case, it is not seen that a search of the small number of subclasses entailed would constitute the requisite "serious burden" in order to justify restriction.

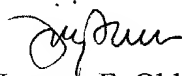
This conclusion is buttressed by the fact that the method of gene expression, polynucleotide and antibody of the present invention constitute a single invention as explained above.

Accordingly, in view of all of the above, it is believed that the requirement for restriction is improper and should be withdrawn.

Favorable consideration is earnestly solicited.

Respectfully submitted,

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ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

ATTORNEYS AT LAW

RE: Application Serial No.: 09/893,485
Applicant(s): MITSUKO ISHIHARA ET AL
Filing Date: JUNE 28, 2001
For: METHOD FOR DETECTING ENDOCRINE
DISRUPTING ACTION OF A TEST SUBSTANCE
Group No.: 1655
Examiner: CHAKRABARTI

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SIR:

Attached hereto for filing are the following papers:

RESTRICTION RESPONSE

Our check in the amount of \$ -0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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